Remarks

Claims 1-40 are pending and under consideration. Applicants have hereinabove amended claims 7, 20 and 22. Applicants have also amended claim 12 and page 24 of the specification to include the sequence identifier "SEQ ID NO:1" in compliance with the sequence rules. Applicants maintain that none of the changes to the claims or the specification raise an issue of new matter. Therefore, entry of this Amendment is respectfully requested.

Claim Objections

The Examiner required correction of claim 20 because while it depends on claim 18, it recites "the antibody and second moiety" for which there allegedly is insufficient antecedent basis. The Examiner stated that for restriction purposes, claim 20 is presumed to depend from claim 19.

In addition, the Examiner required correction of claim 22 because it allegedly uses improper Markush language.

In response, applicants respectfully traverse. Nevertheless, without conceding the correctness of the Examiner's objections and to expedite prosecution of the subject application, applicants have hereinabove amended claim 20 such that it now depends from claim 19 instead of claim 18. In addition, applicants have amended claim 22 to address the Examiner's objection.

In light of the above remarks, applicants respectfully request that the Examiner reconsider and withdraw these grounds of objection.

Sequence Compliance

The Examiner objected to the specification and the claims for allegedly failing to adhere to the requirements of the sequence rules. The Examiner stated that applicants must append SEQ ID Nos. to all mentions of specific sequences in the specification and the claims. The Examiner directed applicants to the HIV Tat peptide sequence in claim 12.

In response, applicants respectfully traverse. Nevertheless, without conceding the correctness of the Examiner's objection and to expedite prosecution of the subject application, applicants have hereinabove amended claim 12 and the specification to include the SEQ ID No. for each sequence in compliance with 37 C.F.R. §1.821(d).

In light of the above remarks, applicants respectfully request that the Examiner reconsider and withdraw this ground of objection.

Election/Restriction

In the Office Action, the Examiner restricted pending claims 1-40 to one of the following allegedly distinct inventions under 35 U.S.C. §121:

I. Claims 1-18, 37, and 38, drawn to a composition comprising an antibody and a peptide moiety, and a kit comprising the composition;

II. Claims 1-22, 39, and 40, drawn to a composition comprising an antibody and a peptide moiety, wherein the antibody is

bound to a second agent, and a kit comprising the composition and reagents for affixing the second agent to the composition;

III. Claim 23, drawn to a method for making the composition of an antibody and a peptide moiety;

IV. Claims 24 and 25, drawn to a method for introducing an antibody into a cell;

V. Claims 26 and 27, drawn to a method for determining whether an agent is present in a cell comprising contacting the cell with an antibody labeled with a detectable marker and a peptide;

VI. Claims 28 and 29, drawn to a method for introducing an agent into a cell comprising affixing the agent to an antibody and contacting the cell with a composition of the antibody and a peptide;

VII. Claims 30, 32-36, drawn to a method for treating a human disorder comprising administering the composition of an antibody that targets an intracellular agent, and a peptide; and

VIII. Claims 31-36, drawn to a method for treating a human disorder comprising administering the composition of an antibody bound to a secondary therapeutic agent, and a peptide.

In response, applicants hereby elect Group I, claims 1-18, 37, and 38, drawn to a composition comprising an antibody and a peptide moiety, and a kit comprising the composition, with

traverse for prosecution at this time.

The Examiner also required the election of species with respect to certain claim groups as follows:

The Examiner stated that if Group I or II is elected, applicant is required to elect a specific peptide from the following:

a) poly-L-lysine;
b) poly-L-arginine;
c) poly-L-ornithine; or
d) SEQ ID NO:1.

In response, applicants hereby elect the species of poly-L-arginine in the event no generic claim is finally deemed allowable.

Applicants, however, respectfully request that the Examiner reconsider and withdraw this restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application.

The inventions of Groups I-VIII are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subject matter claimed. As disclosed in the instant specification, e.g. at page 12, line 29 - page 13, line 1, the relationship between the compositions of the invention is that they allow antibodies to enter cells so they can act intracellularly. Moreover, all the compositions share the same basic structure, i.e. an antibody and a peptide moiety, wherein the peptide moiety comprises an amino acid residue having a nitrogen-containing side chain and wherein the peptide is

covalently bound to a carbohydrate moiety of the antibody (see claim 1). Accordingly, applicants maintain that Groups I-VIII are not independent and restriction is not proper.

Furthermore, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction were not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of Groups I-VIII would not require a serious burden once the prior art for Group I has been identified.

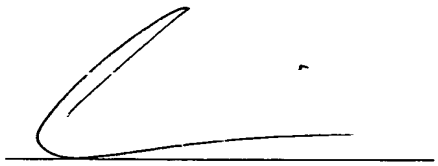
Therefore, there is no burden on the Examiner to examine Groups I-VIII together in the subject application. Hence, applicants maintain that the Examiner must examine the entire application on the merits.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. §121, and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. If any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

8/19/05

Alan J. Morrison
Reg. No. 37,399

Date